

**Notice of Allowability**

Application No.

09/281,717

Examiner

Marjorie A. Moran

Applicant(s)

BAXTER ET AL.

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 3/10/04.
2. ☒ The allowed claim(s) is/are 1-16,31-43 and 52-62.
3. ☐ The drawings filed on \_\_\_\_\_ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All    b) ☐ Some\*    c) ☐ None    of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  6. ☒ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
    - (a) ☒ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
      - 1) ☒ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

- |   |  |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892)  | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                                  |
| 2. <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                     | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),<br>Paper No./Mail Date <u>20040622</u> . |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),<br>Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment  |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit<br>of Biological Material          | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance                         |
|   | 9. <input type="checkbox"/> Other _____  |

Marjorie A. Moran  
Primary Examiner  
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***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submissions filed on 12/16/03 and 3/10/04 have been entered.

***Election/Restrictions***

Claim 1, which is a linking claim to claims reciting various receptors, is allowable for the reasons set forth below. As the linking claim is allowable, claims 34-43 are hereby rejoined with claim 1.

***Drawings***

The drawings filed on 3/30/99 are acceptable subject to correction of the informalities indicated on the attached "Notice of Draftsperson's Patent Drawing Review," PTO-948, originally mailed with the Office Action of 6/14/00. For applicant's convenience, a copy of the Form-948 is included with this Action. In addition, the proposed correction to Figure 7 filed with the response of 11/18/02 has been approved; however, it is noted that a formal copy of an amended drawing has not been filed.

In order to avoid abandonment of this application, correction is required in reply to the Office action. The correction will not be held in abeyance.

***Examiner's Amendment***

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Richard Bone on June 24, 2004.

The application has been amended as follows:

In the Title: Delete "AND COMPOUNDS"

In the claims:

Cancel claims 30 and 51.

Claim 2: In line 2, insert --is a model of human thyroid beta receptor and-- after "model". In lines 2-3, delete "identified by homology alignment with residues". In line 4, delete everything after "Leu454". Also in line 4, after "Leu454", insert --, as shown in Figure 19.-- Delete line 5.

Claim 3: In line 2, insert --is a model of human thyroid beta receptor and-- after "model". In lines 2-3, delete "identified by homology alignment with

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residues". In line 4, delete everything after "Glu457". Also in line 4, after "Glu457", insert --, as shown in Figure 19.-- Delete line 5.

Claim 4: In line 2, insert --is a model of human thyroid beta receptor and-- after "model". In lines 2-3, delete "identified by homology alignment with residues". In line 6, delete everything after "Phe459". Also in line 6, after "Phe459", insert --, as shown in Figure 19.-- Delete line 7.

Claim 5: In line 2, insert --is a coactivator binding site of human thyroid beta receptor and-- after "site". In lines 2-3, delete "identified by homology alignment with residues". In line 6, delete everything after "Phe459". Also in line 6, after "Phe459", insert --, as shown in Figure 19.-- Delete line 7.

Claim 6: In line 2, insert --is a coactivator binding site of human thyroid beta receptor and-- after "site". In lines 2-3, delete "identified by homology alignment with residues". In line 4, delete everything after "Leu454". Also in line 4, after "Leu454", insert --, as shown in Figure 19.-- Delete line 5.

Claim 7: In line 2, insert --is a coactivator binding site of human thyroid beta receptor and-- after "site". In lines 2-3, delete "identified by homology alignment with residues". In line 4, delete everything after "Glu457". Also in line 4, after "Glu457", insert --, as shown in Figure 19.-- Delete line 5.

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- Claim 8: In line 2, insert --is a coactivator binding site of human thyroid beta receptor and-- after "site". In lines 2-3, delete "identified by homology alignment with residues". In line 5, delete everything after "Phe459". Also in line 5, after "Phe459", insert --, as shown in Figure 19.-- Delete line 6.
- Claim 9: In line 1, delete "any one of claims 5 through 8" and insert --claim 1-- after "method of".
- Claim 34: In line 2, insert --is a model of human estrogen alpha receptor and-- before "comprises". In line 2, delete "identified by homology alignment with" and insert --selected from the group consisting of-- after "residues". In line 5, delete everything after "Leu544". Also in line 5, after "Leu544", insert --, as shown in Figure 19.-- Delete line 6.
- Claim 35: In line 2, insert --is a coactivator binding site of human estrogen alpha receptor and-- after "site". In lines 2-3, delete "identified by homology alignment with residues". In line 6, delete everything after "Leu544". Also in line 6, after "Leu544", insert --, as shown in Figure 19.-- Delete line 7.

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- Claim 36: In line 2, insert --is a coactivator binding site of human retinoid receptor hRAR $\gamma$  and-- after "site". In lines 2-3, delete "identified by homology alignment with residues". In line 6, delete everything after "Leu416". Also in line 6, after "Leu416", insert --, as shown in Figure 19.-- Delete line 7.
- Claim 37: In line 2, insert --is a coactivator binding site of human retinoid receptor hRXR $\alpha$  and-- after "site". In lines 2-3, delete "identified by homology alignment with residues". In line 6, delete everything after "Leu455". Also in line 6, after "Leu455", insert --, as shown in Figure 19.-- Delete line 7.
- Claim 38: In line 2, insert --is a coactivator binding site of human peroxisome receptor hPPAR $\gamma$  and-- after "site". In lines 2-3, delete "identified by homology alignment with residues". In line 6, delete everything after "Tyr471". Also in line 6, after "Tyr471", insert --, as shown in Figure 19.-- Delete line 7.
- Claim 39: In line 2, insert --is a coactivator binding site of human vitamin D receptor hVDR and-- after "site". In lines 2-3, delete "identified by homology alignment with residues". In line 6, delete everything after "Phe422". Also in line 6, after "Phe422", insert --, as shown in Figure 19.-- Delete line 7.

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- Claim 40: In line 2, insert --is a coactivator binding site of human glucocorticoid receptor hGR and-- after "site". In lines 2-3, delete "identified by homology alignment with residues". In line 6, delete everything after "Ile757". Also in line 6, after "Ile757", insert --, as shown in Figure 19.-- Delete line 7.
- Claim 41: In line 2, insert --is a coactivator binding site of human progestin receptor hPR and-- after "site". In lines 2-3, delete "identified by homology alignment with residues". In line 6, delete everything after "Ile913". Also in line 6, after "Ile913", insert --, as shown in Figure 19.-- Delete line 7.
- Claim 42: In line 2, insert --is a coactivator binding site of human mineralocorticoid receptor hMR and-- after "site". In lines 2-3, delete "identified by homology alignment with residues". In line 6, delete everything after "Ile964". Also in line 6, after "Ile964", insert --, as shown in Figure 19.-- Delete line 7.
- Claim 43: In line 2, insert --is a coactivator binding site of human androgen receptor hAR and-- after "site". In lines 2-3, delete "identified by homology alignment with residues". In line 6, delete everything after "Ile432". Also in line 6, after "Ile432", insert --, as shown in Figure 19.-- Delete line 7.

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Claim 52: In line 2, insert --comprises data which-- after "model".

### ***Reasons for Allowance***

The following is an examiner's statement of reasons for allowance: applicant has persuasively argued that the prior art neither teaches nor makes obvious a method of modeling a test compound which fits spatially into a nuclear receptor coactivator binding site, as recited in the instant claims.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Conclusion***

Claims 1-16, 31-43 and 52-62 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marjorie A. Moran whose telephone number is (571) 272-0720. The examiner can normally be reached on Mon. to Wed, 7:30-4; Thurs 7:30-6; Fri 7-1 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571)272-0722. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marjorie A. Moran  
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Art Unit 1631

mam

*Marjorie A. Moran*  
*8/24/04*